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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,210	02/08/2001	Fanny Maquaire	TIF-30144	6628

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TEXAS INSTRUMENTS INCORPORATED  
P O BOX 655474, M/S 3999  
DALLAS, TX 75265

EXAMINER
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TRAN, TUAN A

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/779,210

Applicant(s)

MAQUAIRE ET AL.

Examiner

Tuan A. Tran

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The finality of the Office Action mailed on 05/09/2005 is withdrawn.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 10, the limitation "...corresponding to said match between audio input from said user and said one of said templates" has not been described and/or supported by the specification. According to the specification (See fig. 4 and page 6 lines 22-26, page 8 lines 9-14), playing the associated audio file corresponding to the match between a received caller identification and one of telephone numbers stored in the voice activated dialing database. Correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Der Salm (WO 96/27974) in view of Barkat et al. (5,805,672).

Regarding claim 1, Van Der Salm discloses a mobile communication device (See fig. 4) comprising: a database 19 of telephone numbers, one or more the telephone numbers associated with respective audio files (name sound); and a caller identification circuitry 17 for detecting an originating telephone number associated with an incoming telephone and, if the originating is associated with an audio file (name sound), playing the associated audio file (name sound) (See figs. 3-4 and Abstract, page 14 line 5 to line 38). However, Van Der Salm does not mention that the mobile communication device comprising a voice activated dialing circuitry for dialing one of the telephone numbers in response to identifying a match between an audio input from a user and one of templates, and for playing the associated audio sound (sound name) in response to the match. Barkat teaches an accessory voice operated unit integrated with a cellular telephone (See figs. 1-2) comprising a voice activated dialing circuitry for dialing one of pre-stored telephone numbers in response to identifying a match between an audio input from a user and one of templates, and for playing the associated audio sound (sound name) in response to the match (See figs. 2-4 and col. 3 line 26 to col. 5 line 45). Since both Van Der Salm and Barkat disclose devices that utilize database including telephone numbers and its associated audio files (name sound) for getting user's intention during their operations of dialing telephone numbers and receiving

incoming calls; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of Barkat in modifying the mobile device as disclosed by Van Der Salm with the voice activated dialing circuitry as well as configuring both caller identification circuitry and voice activated dialing circuitry to use the same database of the telephone numbers and its associated audio files for the advantage of providing flexibility and convenience to a user by allowing the user to conduct hands-free telephone communication.

Claim 10 is rejected for the same reasons as set forth in claim 1, as method.

Regarding claim 4, Van Der Salm & Barkat disclose as cited in claim 1. Van Der Salm further discloses the caller identification circuitry further plays a distinctive ring associated with the originating telephone number not associated with an audio file (See fig. 3 and page 14 lines 27-38).

Claim 13 is rejected for the same reasons as set forth in claim 4, as method.

Regarding claim 5, Van Der Salm & Barkat disclose as cited in claim 1. Barkat further discloses the audio files are recordings of the user's voice (See col. 4 lines 45-62).

Claim 14 is rejected for the same reasons as set forth in claim 5, as method.

Regarding claims 6, Van Der Salm & Barkat disclose as cited in claim 1. Van Der Salm further discloses the mobile communication device is a cellular telephone (See page 11, lines 9-15).

Regarding claim 7-9, Van Der Salm & Barkat disclose as cited in claim 1.

However, they do not explicitly mention that the mobile communication device is a smart

phone or a PDA or a portable computer. Since smart phone or PDA or a portable computer are known in the art; therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use smart phone or PDA or portable computer as the mobile communication device as disclosed by Van Der Salm & Barkat for the advantage of expanding the capability of the device to various types of mobile communication devices.

3. Claims 2-3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Der Salm (WO 96/27974) in view of Barkat et al. (5,805,672) as applied to claims 1 and 10 above, and further in view of Flannery (2002/0086711).

Regarding claims 2-3, Van Der Salm & Barkat disclose as cited in claim 1. However, they do not mention that the mobile communication device displays the originating telephone number and its associated name on the display. Flannery teaches a portable phone 2 wherein displays the originating telephone number and its associated name on the display in response to an incoming call (See figs. 1-2 and page 1 [0006], page 2 [0018]). Since both Van Der Salm & Barkat and Flannery suggest portable or mobile communication device indicating the user about the incoming calls either audibly or visually; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the mobile communication device to display the originating telephone number and its associated name for the advantage of expanding the capability of the device to various types of call-alerted

indications as well as allowing the user to visually identify the caller to accept and/reject the incoming call.

Claims 11-12 are rejected for the same reasons as set forth in claims 2-3, as method.

### ***Response to Arguments***

Applicant's arguments filed 04/06/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references (See Brief, page 3), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Van Der Salm discloses device comprising caller identification circuitry that utilizes database including telephone numbers and theirs associated audio files (name sound) for getting user's intention during its operation of receiving incoming calls and Barkat discloses device comprising voice activated dialing circuitry that utilizes database including telephone numbers and theirs associated audio files (name sound) for getting user's intention during its operation of dialing telephone numbers. Therefore, Van Der Salm in view of Barkat wherein device's caller identification circuitry and device's voice

activated dialing circuitry utilize the same database of telephone numbers and their associated audio files (name sound), would arrive to the claimed invention.

The Applicant argued that there is no suggestion to combine Van Der Salm and Barkat because "Van Der Salm emphasized the algorithmic conversion of caller identification information into ring tones to avoid a large memory containing ring tones, and this counters any suggestion that a name recognition database" (See remark, page 3). The Examiner respectfully disagrees with the Applicant's argument. In this instant case, Van Der Salm does teach a memory 19 (database) for storing telephone numbers with their associated customized audio files for use by the caller identification circuit (See page 16, lines 25-36, page 19 line 37 to page 20 line 2) and Barkat teaches a database for storing customized audio files with their associated telephone numbers for use by the voice activated dialing circuitry (See figs. 2-4 and col. 3 line 26 to col. 5 line 45). Since both Van Der Salm and Barkat teach the utilization of database containing telephone numbers and their associated audio files by circuitry of mobile communication device; therefore they are combinable.

For the above reasons, the Applicant's arguments are not persuasive and the Examiner maintains the rejections.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A. Tran whose telephone number is (571) 272-7858. The examiner can normally be reached on Mon-Fri, 10:00AM-6:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on (571) 272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tuan Tran



Matthew D. Anderson  
SPE - 2618